

Application Ser. No. 09/911,243
Response to Office Action Mailed September 25, 2003

REMARKS

In response to the office action, reconsideration of claims 17-26 is respectfully requested.

Claims 17-26 were rejected in the office action under 35 U.S.C. § 103 as being unpatentable over Kezuka et al U.S. Patent 4,614,632 (Kezuka) in view of Wenning et al U.S. Patent 5,792,487 (Wenning) .

In this ground of rejection, the Examiner contends that it would be obvious to one of ordinary skill in the art to modify Kezuka with rollers as taught by Wenning in order to arrive at the claimed subject matter. It is respectfully submitted that the Examiner has erred in this ground of rejection.

Claims 17-26 are directed to a device for preventing breakage of a polymeric film or nonwoven web during stretching. The device of claims 17-26 basically comprises interdigitating rollers for stretching a length of film or web along a plurality of lines across its width except in a substantially unstretched area of the film adjacent to the stretched lines along its length. A controller or disc is employed for contacting the film or web area and pressing the unstretched area into the first interdigitating roller without substantially stretching the film or web in the area adjacent to the lines during the interdigital stretching.

Neither Kezuka or the Wenning patents disclose interdigital rollers which serve to stretch a film or web. In fact, both references are directed to

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molding corrugated extrusions of plastic material. Furthermore, neither of the patents relied upon gives any hint of the problem which is addressed by and solved by apparatus claims 17-26, namely, providing a mechanical element or controller which creates slack during stretching of a polymeric film or nonwoven web to prevent breakage. This is accomplished by the controller which presses the unstretched area of the film. Furthermore, there is no disclosure or suggestion of how the problem may be solved by referring to either of the cited Kezuka or Wenning patents.

The Examiner has erred in referring to Wenning as suggesting that elements 14a, 14b and 14c are "controllers" of any type. These elements are simply cooling rollers which decrease the temperature of the extruded plastic film prior to molding the extruded material which still retains its moldable temperature. In no way may these cooling rollers be construed as creating slack by pressing against the film without substantially stretching it adjacent the lines along which the web or film is interdigitally stretched.

In brief, neither of the cited patents is directed to incrementally stretching rollers for stretching a plastic film or web. Furthermore, neither of these patents calls for the use of a mechanical element or a controller to create a slack or substantially unstretched area during the process of incremental stretching to prevent breakage. In other words, neither of the patents disclose

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the essential elements of independent claims 17 and 21. Wherefore, there is absolutely no factual support for a conclusion of obviousness of claims 17-26.

The MPEP, under Section 706.02(j) states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - 2143.03 for decisions pertinent to each of these criteria. (Emphasis added.)

The Examiner's rejection makes reference to the Supreme Court of the United States' decision in Graham v. John Deere, 383 U.S. 1, 148 (1966), but fails to follow through in presenting factual basis for the rejection of claims 17-26. As expressed by the Court of Customs and Patent Appeals in In re Warner and Warner, 379 F.2d 1011, 154 U.S.P.Q. 173, at 177 and 178 (CCPA 1967):

We think the precise language of 35 U.S.C. 102 that 'a person shall be entitled to a patent unless' concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103.

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The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis. (Court's emphasis)

"The Supreme Court in Graham [Graham v. John Deere Co., 383 U.S. 1], and Adams [United States v. Adams, 383 U.S. 39] *supra*, foreclosed the use of substitutes for facts in determining obviousness under section 103. The legal conclusion of obviousness must be supported by facts." (Court's emphasis)

Applicant urges that absent the use of assumptions and impermissible hindsight¹, there is no motivation² in the applied prior art to have modified their disclosures to arrive at the claimed invention³.

¹The use of hindsight knowledge derived from the appellant's own disclosure to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W.L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

²Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

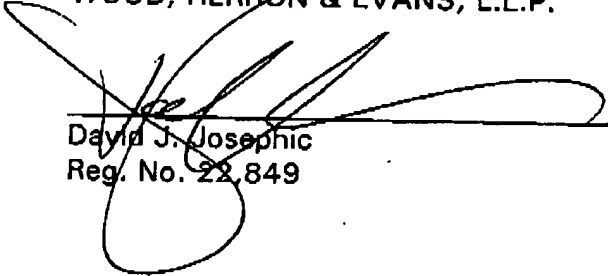
³A case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071,

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In conclusion, for the above reasons, in view of the authorities relied upon, claims 17-26 are patentable and their allowance is earnestly solicited. If any issues remain, the Examiner is encouraged to call the undersigned attorney.

Respectfully submitted,

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1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).